



Docket No.: 49657-870

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of

Koji EGUCHI

Serial No.: 09/732,926

Filed: December 11, 2000

: Customer Number: 20277
: Confirmation Number: 2307
: Group Art Unit: 2154
: Examiner: Aaron C. Perez Daple

For: PRODUCT CONTROL METHOD USING WIRELESS COMMUNICATION

TRANSMITTAL OF APPEAL BRIEF

Mail Stop Appeal Brief
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Submitted herewith in triplicate is Appellants' Appeal Brief in support of the Notice of Appeal filed July 29, 2004. Please charge the Appeal Brief fee of \$330.00 to Deposit Account 500417.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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This Appeal Brief is submitted in support of the Notice of Appeal filed July 29, 2004.

REAL PARTY IN INTEREST

The real party in interest is Renesas Technology Corporation, the assignee of the entire right, title and interest in and to the above-identified U. S. Application.

RELATED APPEALS AND INTERFERENCES

No other appeals or interferences are known to the Appellant, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

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STATUS OF CLAIMS

Claims 1-15 are pending. These claims stand under final rejection, from which rejection this appeal is taken.

STATUS OF AMENDMENTS

In accordance with the Advisory Action of July 21, 2004, the amendment under 37 CFR 1.116 filed on June 1, 2004 will be entered for purposes of Appeal.

SUMMARY OF INVENTION

The present invention relates to a method of controlling process of producing products. The method makes it easy for an operator to control the production process and monitor product conditions throughout the process. As shown in FIG. 1 of the drawings, a system for carrying out the process involves a process controlling host computer 100 with a portable telephone communication interface 122, and multiple portable telephones 200, each of which is associated with a production lot combining products with the same production number.

The host computer 100 stores a control table containing control data required for controlling production process in connection with a particular production lot. As shown in FIG. 3, the control table may include, for example, a number identifying a particular production lot, a number identifying the telephone 200 associated with the lot, the production number associated with the lot, operation process data indicating processes carried out in connection with products in the lot, and change data indicating required changes in the processes. FIGS. 4-6 illustrate various operation process data.

The portable telephone 200 interacts with the host computer 100 during the production process. In particular, as illustrated in FIG. 11, the portable telephone 200 transmits to the host computer 100 a request for the control data and the telephone's identification number. In response, as illustrated in FIG. 12, the host computer 100 retrieves the requested control data for the product corresponding to the telephone's identification number, and transmits the data to the telephone identified by the identification number. As shown in FIG. 13, the telephone 200 receives the control data from the host computer 100 and displays the control data for an operator.

As a result, an operator is enabled to control the production process and monitors product conditions during the production process.

ISSUES

Whether claims 1-15 are unpatentable under 35 U.S.C. 103 over Angle (US 6,366,771) in view of the U.S. (US 6,615,094) or German (DE 19829366) patent to Gleis. As indicated by the Examiner, the U.S. and German patents to Gleis disclose the same invention.

As indicated in the Interview Summary mailed on August 8, 2004, the rejection of claim 3 under 35 U.S.C. 112, second paragraph, has been withdrawn by the Examiner in view of the Amendment under 37 CFR 1.116 filed on June 1, 2004.

GROUPING OF CLAIMS

Appellant submits that the claims of each rejected group do not stand or fall together, the claims being considered to be separately patentable for the reasons presented in the Argument section of this Brief.

THE ARGUMENT

In the application of a rejection under 35 U.S.C. §103, it is incumbent upon the Examiner to factually support a conclusion of obviousness. As stated in *Graham v. John Deere Co.* 383 U.S. 1, 13, 148 U.S.P.Q. 459, 465 (1966), obviousness under 35 U.S.C. §103 must be determined by considering (1) the scope and content of the prior art; (2) ascertaining the differences between the prior art and the claims in issue; and (3) resolving the level of ordinary skill in the pertinent art. The Examiner must provide a reason why one having ordinary skill in the art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985). *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967).

Claim 1 recites a product control method of controlling processes of producing a product by wireless communication between a communication device associated with said product and a computer controlling said process of producing said product, comprising the steps of:

- preparing in said computer a control table storing control data controlling said product corresponding to an identification number for identifying said communication device;

- transmitting said identification number and information requesting the control data, from said communication device to said computer by wireless communication;

- transmitting, from said computer to said communication device identified by said identification number, control data stored in said control table corresponding to said received identification number in response to reception of said identification number and said information requesting the control data from said communication device;

- receiving in said communication device said control data from said computer;
and

- outputting control data relating to said product in a form recognizable to a person based on said received control data.

The Examiner takes the position that Angle differs from the claimed invention only in that the reference does not disclose associating the communication device to a product. Gleis is relied upon for disclosing this feature.

Considering the references, Angle discloses a wireless network including a plurality of access points coupled to a backbone, and a plurality of portable data terminals.

As demonstrated below, none of the applied references discloses the step of preparing a control table storing control data controlling said product corresponding to an identification number for identifying said communication device, and the subsequent steps of data exchange based on the control data and the identification number.

The Examiner relied upon col. 10, lines 37-48 of Angle for disclosing the step of preparing a control table. However, this portion of the reference discloses a table that stores network addresses of various devices of the network, and nicknames associated with the corresponding network addresses. For example, the table stores the first name of an operator of a network terminal, together with the network address of the terminal, and the nickname of each recipient.

Accordingly, Angle does not teach or suggest storing for a product, control data corresponding to the identification number of the communication device associated with the product, as claim 1 requires.

It is noted that in the final Office Action, the Examiner admits that the teaching of Angle is “in the context of sending voice data.” The Examiner takes the position that “in the context of a manufacturing facility, it would be obvious to one of ordinary skill in the art that this data could comprise “control data controlling said product.”

The Examiner’s conclusion of obviousness is respectfully traversed for the following reasons.

It is well settled that the test for obviousness is what the combined teachings of the references would have suggested to those having ordinary skill in the art. *Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F.2d 1015, 226 USPQ 881 (Fed. Cir. 1985). In determining whether a case of *prima facie* obviousness exists, it is necessary to ascertain whether the prior art teachings appear to be sufficient to one of ordinary skill in the art to suggest making the claimed substitution or other modification. *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1984).

It is respectfully submitted that the Angle teaching of a table that stores network addresses of various devices of the network, and nicknames associated with the corresponding network addresses, is not sufficient to one skilled in the art to arrive at the claimed control table that stores control data for a manufactured product in correspondence with the identification number of the communication device associated with this product.

Angle does not teach or suggest any process for producing a product, and does not teach or suggest storing control data for the product in correspondence with the identification number of the communication device associated with the product being produced. Accordingly, the reference provides no suggestion to prepare the control table in the manner required by claim 1.

Further, the Examiner contends that it would have been obvious that instead of transmitting voice data, the methods of Angle could be used in the transmission of control data stored in a table. The Examiner takes the position that a computer database inherently stores data in a tabular format, and that a method of transmission of control data “is arguably inherent to Angle.”

It is well settled that relying on inherency requires certainty, not speculation. *In re Rijckaert*, 9 F.3rd 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *In re King*, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986); *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983); *In re Oelrich*, 666 F.2d 578, 212 USPQ 323 (CCPA 1981); *In re Wilding*, 535 F.2d 631, 190 USPQ 59 (CCPA 1976). To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by

persons of ordinary skill. Inherency, however, may not be established by probability or possibilities. *In re Robertson*, 169 F.3d 743, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

However, the Examiner provided no factual basis upon which to conclude that the Angle's table (that stores network addresses of various devices of the network, and nicknames associated with the corresponding network addresses) necessarily stores control data for a product in correspondence with the identification number of the communication device associated with that product.

Also, the Examiner provided no evidence that Angle's system necessarily transmit control data for a product stored in a control table in correspondence with the identification number of the communication device associated with that product, as claim 1 requires.

Moreover, it is respectfully submitted that one skilled in the art would have no reason to conclude that Angle's table stores the control data in the manner required by claim 1 and that Angle's system transmits the control data stored in the requisite manner.

As neither Angle nor Gleis teaches or suggests the claimed step of preparing a control table storing control data controlling the product corresponding to an identification number for identifying the communication device associated with the product, the reference combination applied by the Examiner is not sufficient to suggest this step.

Moreover, it is submitted that the reference combination would not suggest the claimed steps reciting an information exchange between the computer and

communication device involving the control data associated with the identification number of the communication device.

Accordingly, the combination of Angle with Gleis is not sufficient to arrive at the method recited in claim 1. Hence, the rejections of this claim under 35 U.S.C. 103 is unwarranted.

Independent claim 11 recites a product control method of controlling a process of producing a product by a communication device associated with said product and a computer controlling said process of producing said product by wireless communication, comprising the steps of:

- preparing in said computer registration data of said product corresponding to an identification number for identifying said communication device;
- selecting said product stored in said registration data;
- transmitting calling data from said computer to said communication device designated by said identification number corresponding to said product selected in said step of selecting said product; and
- performing a prescribed operation in said communication device identified by said calling data based on said received calling data in response to reception of said calling data from said computer.

The Examiner relies upon col. 10, lines 37-48 for disclosing the step of preparing registration data.

As discussed above, this portion of the reference discloses a table that stores network addresses of various devices of the network, and nicknames associated with the corresponding network addresses.

Hence, Angle does not describe preparing registration data of the product corresponding to an identification number for identifying the communication device associated with that product, as claim 11 requires.

In the final Office Action, the Examiner asserts that he finds this limitation to be obvious in view of Gleis. The Examiner concludes that “if Angle was modified to associate the communication device with the product, as argued in the previous rejection, then the step of “preparing registration data” would inherently follow.”

First, as discussed above, to establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. *In re Robertson, supra.*

The Examiner has failed to provide any factual basis upon which to conclude that the suggested modification of Angle would necessarily involve preparing registration data in the manner required by claim 11.

Second, in rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to provide a reason why one having ordinary skill in the art would have been led to modify the prior art to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or inference in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. *Uniroyal, Inc. v. Rudkin-Wiley*, 837 F.2d 1044, 5 USPQ 2d 1434 (Fed. Cir. 1988); *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985); *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 221 USPQ 929 (Fed. Cir. 1984); *In re Sernaker*, 702 F.2d 989, 217 USPQ 1 (Fed. Cir. 1983).

This showing by the Examiner is an essential part of complying with the burden of presenting a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

Appellant respectfully submits that the Examiner has failed to provide the requisite reason for modifying Angle to arrive at the step of preparing registration data of the product corresponding to an identification number for identifying the communication device associated with that product, as claim 11 requires.

It is respectfully submitted that neither Angle nor Gleis teaches or suggests preparing registration data for a product in correspondence with an identification number of a communication device associated with that product. Therefore, none of these references would suggest to one skilled in the art the step of preparing registration data in the manner recited in claim 11.

In the absence of such a prior art suggestion for modification of the reference, the basis of the rejection is no more than inappropriate hindsight reconstruction using appellant's claims as a guide. *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967).

Inasmuch as the applied combination of references does not teach or suggest the claimed step of preparing registration data, the prior art cannot suggest the other claimed steps involving operations with the registration data.

Accordingly, the rejection of claim 11 under 35 U.S.C. 103 is improper. Dependent claims 2-10 and 12-15 are defined over the prior art at least for the reasons presented above in connection with the respective independent claims 1 and 11.

Moreover, it is respectfully submitted that each of these claims is considered to be separately patentable because the applied combination of references would not teach or suggest the following features recited in these claims:

-the control data including progress status information on said product in said processes and process condition data in said processes, and the step of outputting said control data including the step of outputting process condition data, as claim 2 recites;

-the product control method further including the step of transmitting modified process condition data to a production facility for producing the product by wireless communication from said communication device, as claim 3 recites;

-the control data including operation results at said producing process, and the step of outputting said control data including the step of outputting in said communication device said operation results in the form recognizable to the person, as claim 4 recites;

-the step of transmitting operation results at said process from said communication device to said computer, as claim 5 recites;

-the step of receiving said operation results from said production facility by wireless communication in said communication device, as claim 6 recites;

-the communication device attached to said product being a communication device having a bar code reading device, bar code indicated a plurality of operation results is prepared in said process, and said product control method including the step of reading said bar code selected by the operator, as claim 7 recites;

-the step of taking an image of said product after said operation in said process, wherein said result data is image data, in said image taking step, representing a product after the operation, as claim 8 recites;

-said communication device attached to said product being a portable telephone device having an image pickup device, and said step of taking an image of said product after said operation including the step of taking an image of said product after said operation in said process using said image pickup device of said portable telephone device, as claim 9 recites;

-said communication device attached to said product being a portable telephone device, as claim 10 recites;

-the registration data being data of said products divided into a plurality of groups, said step of selecting said product including the step of selecting one of said plurality of groups, and the step of transmitting calling data including the step of transmitting first calling data from said computer to said communication device identified by said identification number corresponding to the products included in said one group, as claim 12 recites;

-the step of transmitting said calling data including the step of transmitting first calling data from said computer to said communication device identified by said identification number corresponding to said product included in said one group, as claim 13 recites;

-the step of selecting said product further including the step of selecting another group, other than said one group, among said plurality of groups, the step of transmitting said calling data further including the step of transmitting second calling data from said

computer to said communication device identified by said identification number corresponding to the product included in said another group, and the step of performing said prescribed operation including the step of selectively performing first and second operations based on a fact that said calling data is said first or second calling data in response to reception of said calling data from said computer, as claim 14 recites;

-the communication device attached to said product being a portable telephone device, and said prescribed operation outputs ringing tones of said portable telephone device from a speaker, as claim 15 recites.

CONCLUSION

For the reasons advanced above, Appellant respectfully contends that the rejections of claims 1-15 as being obvious under 35 U.S.C. § 103 are improper as the Examiner has not met the burden of establishing a *prima facie* case of obviousness.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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APPENDIX

1. (Previously Presented) A product control method of controlling processes of producing a product by wireless communication between a communication device associated with said product and a computer controlling said process of producing said product, comprising the steps of:

preparing in said computer a control table storing control data controlling said product corresponding to an identification number for identifying said communication device;

transmitting said identification number and information requesting the control data, from said communication device to said computer by wireless communication;

transmitting, from said computer to said communication device identified by said identification number, control data stored in said control table corresponding to said received identification number in response to reception of said identification number and said information requesting the control data from said communication device;

receiving in said communication device said control data from said computer; and
outputting control data relating to said product in a form recognizable to a person based on said received control data.

2. (Previously Presented) The product control method according to claim 1, wherein said control data include progress status information on said product in said processes and process condition data in said processes, and

said step of outputting said control data includes the step of outputting process condition data in a following process of said product in the form recognizable to the person.

3. (Previously Presented) The product control method according to claim 2, wherein said product control method further includes the step of transmitting modified process condition data to a production facility for producing said product by wireless communication from said communication device.

4. (Original) The product control method according to claim 1, wherein said control data includes operation results at said producing process, and
 said step of outputting said control data includes the step of outputting in said communication device said operation results in the form recognizable to the person.

5. (Original) The product control method according to claim 1, further comprising the step of transmitting operation results at said process from said communication device to said computer.

6. (Original) The product control method according to claim 5, further comprising the step of receiving said operation results from said production facility by wireless communication in said communication device.

7. (Original) The product control method according to claim 5, wherein said communication device attached to said product is a communication device having a bar code reading device, bar code indicated a plurality of operation results is prepared in said process, and said product control method further includes the step of reading said bar code selected by the operator.

8. (Original) The product control method according to claim 5, further comprising the step of taking an image of said product after said operation in said process, wherein said result data is image data, in said image taking step, representing a product after the operation.

9. (Original) The product control method according to claim 8, wherein said communication device attached to said product is a portable telephone device having an image pickup device, and said step of taking an image of said product after said operation includes the step of taking an image of said product after said operation in said process using said image pickup device of said portable telephone device.

10. (Original) The product control method according to claim 1, wherein said communication device attached to said product is a portable telephone device.

11. (Previously Presented) A product control method of controlling a process of producing a product by a communication device associated with said product and a computer controlling said process of producing said product by wireless communication, comprising the steps of:

preparing in said computer registration data of said product corresponding to an identification number for identifying said communication device;

selecting said product stored in said registration data;

transmitting calling data from said computer to said communication device designated by said identification number corresponding to said product selected in said step of selecting said product; and

performing a prescribed operation in said communication device identified by said calling data based on said received calling data in response to reception of said calling data from said computer.

12. (Original) The product control method according to claim 11, wherein said registration data is data of said products divided into a plurality of groups,

said step of selecting said product includes the step of selecting one of said plurality of groups, and

said step of transmitting calling data includes the step of transmitting first calling data from said computer to said communication device identified by said identification number corresponding to the products included in said one group.

13. (Original) The product control method according to claim 12, wherein said step of transmitting said calling data includes the step of transmitting first calling data from said computer to said communication device identified by said identification number corresponding to said product included in said one group.

14. (Original) The product control method according to claim 12, wherein said step of selecting said product further includes the step of selecting another group, other than said one group, among said plurality of groups,

said step of transmitting said calling data further includes the step of transmitting second calling data from said computer to said communication device identified by said identification number corresponding to the product included in said another group, and

said step of performing said prescribed operation includes the step of selectively performing first and second operations based on a fact that said calling data is said first or second calling data in response to reception of said calling data from said computer.

15. (Original) The product control method according to claim 11, wherein said communication device attached to said product is a portable telephone device, and said prescribed operation outputs ringing tones of said portable telephone device from a speaker.